

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : June 16, 2006
Eser Kandogan et al. : Group Art Unit: 2635
Serial No.: 09/991,140 : Examiner: T. Edwards
Filed: November 16, 2001 : San Jose, California
Title: **APPARATUS AND METHOD USING COLOR-CODED OR PATTERN-
CODED KEYS IN TWO-KEY INPUT PER CHARACTER TEXT ENTRY**

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This Reply Brief is in response to The Examiner's Answer ("Answer") of April 17, 2006, in which he maintained his rejection of all the claims. Most of the Examiner's arguments have already been addressed in Appellant's Appeal Brief of February 14, 2006. Thus, rather than offer a comprehensive point-by-point rebuttal of every assertion made by the Examiner in his April 17 response, Applicants will address only certain items whose clarification might be particularly helpful in promoting understanding of the differences between their invention as claimed and the prior art.

1. In his discussion of Claim 1, the Examiner stated on the last line of page 4 and continuing through line 3 of page 5:

With respect to the limitation ‘selecting a first key with a user’s finger or stylus and then selecting a key displaying the first marking with a user’s finger or stylus’. (sic) Stone discloses concurrent key selection. This limitation does not preclude the concurrent touching of two keys by a users (sic) finger. (emphasis added)

Unfortunately, the Examiner has misquoted the language of Applicants’ Claim 1, which states in pertinent part:

by first selecting the first key with a user’s finger or stylus and then selecting a key displaying the first marking with the user’s finger or stylus (emphasis added)

Thus, the same finger or stylus is used to select both keys. There is no other way to understand the italicized word “the”. This limitation is clearly directed to the sequential actuation of keys—not the concurrent actuation of keys as taught in Stone—since it is clear that the user’s finger or stylus can only be in one place at a time. Having misquoted the language of Applicants’ Claim 1, the Examiner then went on to rebut Applicants’ case, but had he properly read and understood Claim 1, he might have been more favorably disposed to it.

2. On page 9 and elsewhere throughout the Answer, the Examiner argued that the phrase “the same finger” is not found in the specification. However, this argument is really a red herring—strictly speaking, the phrase “the same finger” does not appear in the claims either. More to the point, although this phrase is implied by the language of Claim 1, there is in fact support in the specification for this claim as written.

Applicants addressed the issue of support for the language of Claim 1 in their Office action response of February 15, 2005. For example, they pointed to page 9, lines 3-5, of the specification, which states that an advantage of the invention is that it can reduce “the time it takes to complete the two-key sequence, as a result of the shorter distance moved by the user's finger” (emphasis added). (Note that “finger” is singular and implies that one finger is being used.) Applicants also pointed to Figure 13 and the associated discussion on page 16, lines 11-13, which states that “key selections may be made with a stylus, so that letters may be “written” through stroking actions...” (emphasis added) Figure 13 clearly shows a single stylus being used—one can not follow along one of the continuous stylus paths of Figure 13 and believe that multiple styluses are employed to generate it.

3. The Examiner also argued on page 9 of his Answer that “solving disambiguation....[is] not recited in the rejected claims(s)”. But this misses the point—the issue is not whether the word “disambiguation” or any other particular word is cited in the claims, but whether the claims as written are directed to patentable subject matter.

Applicants would once again like to point out that the claims as written completely distinguish Stone and any obvious variations of Stone, since the limitations of Applicants’

claims point to apparatuses or methodologies that only make sense in the context of sequential key selection. The claimed apparatuses and methodologies cannot be used with Stone's concurrent key actuation techniques (which require the use of a minimum of two fingers), a point that has already been discussed by Applicants in some detail (see, for example, pages 9-16 of their Appeal Brief).

4. Likewise, the Examiner argued on page 16 of his Answer with respect to Claim 10 that

it is noted that the features upon which applicant relies (i.e. solving disambiguation, color-code and pattern-code arrangements) are not recited in the rejected claim(s)

On the contrary, there are numerous limitations in Claim 10 (and the claims from which it depends) directed to pattern and/or color coding.

Applicants' arguments in support of Claims 13, 14, 18, 19, 22, 24, 25, and 26 were rebutted by the Examiner on similar grounds. However, these claims also include limitations directed to pattern and/or color coding.

5. The Examiner's basic argument seems to be that the invention of Stone can be incorporated into "any device having a keyboard to enter alphanumeric data, regardless of the number of keys on the device" (quoting from page 9 of the Answer) and thus Stone would render obvious any and all conceivable color-coding arrangements and

methodologies, regardless of i) their complexity, ii) whether they rely on the same operating principle of Stone or iii) whether they would work at all using the operating principle of Stone. Shortcomings behind this line of reasoning have been discussed on pages 14-15 of Applicants' Appeal Brief.

The Examiner's logic has been taken to its extreme with his rejection of Claims 32-37, each of which offers complicated and detailed limitations regarding key selection and layout. It should be clear from even a casual reading of these claims that Stone's concurrent key actuation approach can not work with these embodiments, which only make sense in the context of Applicants' invention.

The rejection of Claim 35 is particularly odd. This claim should be compared with Claim 38 of US Patent 6,765,556, which has the same inventors and filing date of the pending application. That patent, and in particular Claim 38 of that patent, was allowed because the combination of the keyboard layout and the sequence of instructions for converting the sequences "5, 4; 5, 5; and 5, 6 into the letters J, K, and L respectively" was deemed by the Patent Office to be patentable—note that Claim 38 of that issued patent made no reference to any color-coding arrangement. Pending Claim 35 takes Claim 38 of the issued patent one step further by combining the subject matter of issued Claim 38 with a color-coding arrangement—one could think of pending Claim 35 as a claim dependent from issued Claim 38. Nevertheless, the position of the Examiner is that the subject matter of pending Claim 35 is not patentable, because it includes limitations directed to color-coding. What is to be made of this? The Examiner evidently finds the teaching of Stone so

powerful that the subject matter of any claim that includes a limitation directed to color-coding is not patentable, even if the underlying invention itself is patentable.

Respectfully submitted,

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